

Appl. No. 09/980,797  
Atty. Docket No. 7656M  
Amdt. dated March 9, 2004  
Reply to Office Action of June 26, 2003  
Customer No. 27752

### REMARKS

Claims 26-36; 42 (in part); and 43-49 are pending in the present application. New Claims 43 - 49 have been added. Any additional claims fees are to be charged to Applicants' account.

Claims 1-25; 37-41; and 42 (in part), are canceled without prejudice.

Claims 26-29; 35; and 42 have been currently amended.

Claim 26 has been amended to qualify the effective level of solvent less than 7.5% organic solvent. The basis for the amendment is found *inter alia* at page 6, line 17 of the specification.

Claims 27, 28, and 29 have been amended to address the Office Action's 112, second paragraph rejection. The phrase "polyquaternary ammonium [[salt]]" has been replaced with -- polyquaternary ammonium fabric softener active. The basis for the amendment is found *inter alia* previously presented Claim 26.

Claim 29 has been also amended to qualify the effective level of solvent less than 5% organic solvent. The basis for the amendment is found *inter alia* at page 6, line 18 of the specification (making reference to WO 01/02523).

Claim 32 has been amended to qualify the bilayer modifier to comprise levels greater than 1% to about 20% by weight of the composition of polar and/or non-polar hydrophobic oil. The basis for the amendment is found *inter alia* at page 11, line 12 of the specification.

Claim 35 has been amended to depend from pending Claim 26 (opposed to canceled Claim 22).

Claim 42 has been amended to be commensurate in scope with base claim 26 (per the restriction requirement).

Basis for new Claim 43 is found *inter alia* at Claims 26, 32, 33, and 34; and at page 11, line 12 of the specification for limiting hydrophobic/hydrophilic oils above 1% by weight of compositions.

Basis for new Claim 44 is found *inter alia* at Claim 29.

Basis for new Claim 45 is found *inter alia* at Claim 26.

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Basis for new Claim 46 is found *inter alia* at page 6, line 17 of the specification.

Basis for new Claim 47 is found *inter alia* at Claim 32 and at page 11, line 12 of the specification.

Basis for new Claim 48 is found *inter alia* at Claim 33.

Basis for new Claim 49 is found *inter alia* at Claim 34.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

**I. Rejection Under 35 USC 102 over EP 803,498 in view of US 5,670,472 and admissions**

The Office Action rejects claims 26-29, 35 and 36 under 35 U.S.C. section 102(b) as being anticipated by EP 803,498 in view of Keys, US 5,670,472 and applicant's alleged admissions. According to the Federal Circuit, "'For a prior art reference to anticipate in terms of 35 U.S.C. section 102, every element of the claimed invention must be identically shown in a single reference.' . . . These elements must be arranged as in the claim under review. . . . but this is not an 'ipsissimis verbis' test . . . ." *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Applicants respectfully assert that the Office Action in rendering the 102 rejection has not relied upon a single reference. As such, Applicants submit the rejection is improper and request withdrawal.

**II. Rejection Under 35 USC 103(a) over EP 803,498 in view of US 5,670,472 and admissions**

Claims 26-32, 35 and 36 are rejected under 35 USC 103(a) as being unpatentable over EP 803,498 in view of Keys (presumably US 5,670,472) and Applicant's alleged admissions.

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met per MPEP §2142 and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior

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art reference (or references when combined) must teach or suggest all the claim limitations. All three criteria must be met to establish a *prima facie* case of obviousness.

**1. All claim limitations are not taught or suggested**

Applicants respectfully assert that the Office Action fails to demonstrate that EP 803,498 in view of Keys (presumably US 5,670,472) and Applicant's alleged admissions teaches or suggests all of the claim limitations of the present invention.

**a. Office Actions fails to teach fabric softener active claim limitation.**

Firstly, as to the polyquaternary fabric softener active claim limitation,<sup>1</sup> at paragraph 7 of the Office Action, the Examiner admits that EP 803,498 does not disclose that the disclosed polyquaternary compound meets the bilayer limitations, but alleges that Applicants' specification states at the top of page 5 that the compounds of Keys reference [*presumably* US 5,670,472] meets these limitations, and the compounds of the examples in the EP read on those disclosed by Keys.

For purposes of clarification, Applicants' make the assumption that the Office Action relies upon international publication number WO 01/02523 when making reference to Applicants' application. Turning to page 5 of WO 01/02523, the Office Action, in reliance for Applicants' alleged admissions, is presumably referring to line 29 of page 4 wherein Applicants state, "Suitable polycationic softener compounds can be found in the art including ...U.S. Pat. No. 5,670,472, Keys, issued Sep 23,1997 ... ."

Applicants are not claiming in independent Claim 26, with respect to the polyquaternary fabric softener active claim limitation, all "polycationic softener compounds" generally, but rather a specific species of polycationic softener compounds (more precisely polyquaternary ammonium fabric softener actives) characterized *inter alia* either having a phase transition temperature in the presence of less than about 5% organic solvent or water of less than about 50°C or having no significant endothermic phase transition in the region -50°C to 100°C, wherein said actives being in a bilayer.

To support this assertion, Applicants direct the Examiner to lines 22-28 at page 5 of WO 01/02523 wherein Applicants state:

<sup>1</sup> "from about 1% to about 80% by weight of the composition, of **polyquaternary ammonium fabric softener active** which either has a phase transition temperature in the presence of less than about 5% organic solvent or water of less than about 50°C or which has no significant endothermic phase transition in the region -50°C to 100°C, said active being in a bilayer" See Presently Amended Claim 26.

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"An indicator of the suitability of softener actives for use in the composition of this invention is the phase transition temperature. Preferably, the phase transition temperature of the softener active or mixture of actives, containing less than about 5% organic solvent or water, is less than about 50°C, more preferably ...."

"The phase transition temperature can be measured with a Mettler TA 3000 differential scanning calorimeter with Mettler TC 10A Processor."

The Office Action's 103 rejection based in part on Applicants' alleged admission, at best Applicants submit, is ostensibly guised as impermissible "hindsight reconstruction." According to well-established Federal Circuit jurisprudence, "Obviousness may **not** be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Manufacturing Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085 (Fed. Cir. 1995). Thus, Applicants respectfully assert, the cited references at page 5 of the specification are directed to suitable polycationic softener compounds *generally*, some of which, only in view of Applicants' teachings, meet the limitations of polyquaternary fabric softener active claim limitation of Claim 26.

b. In view of claim amendment, Office Action fails to teach less than 7.5% organic solvent claim limitation.

Applicants amend independent Claim 26 such that claimed composition comprises an effective level of less than 7.5% organic solvent. Applicants respectfully submit that the examples of EP 603 498, at best, comprises 7.5% of organic solvent.

c. In view of claim amendment, Office Action fails to teach from greater than 1% to about 20% by weight of the composition of polar and/or non-polar hydrophobic oil.

Applicants amend Claim 32 which notably claims a bilayer modifier comprising *inter alia* from 1% to about 20% by weight of the composition of polar and/or non-polar hydrophobic oil. The Office Action states it would have been obvious to make such a composition because the examples (presumably of EP 0 803 498) contain fragrance, and these commonly consist of hydrophobic oils. Applicants respectfully assert the although Office Action fails to establish that fragrance acts as bilayer modifier, Applicants nevertheless amend Claim 32 (and new Claim 43), in the relevant part and for purposes of clarification, a bilayer modifier comprising from greater than 1% to about 20% by weight of the composition of polar and/or non-polar hydrophobic oil. At

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best, Applicants submit, the fragrance levels of the examples of EP 803 498 appear to only disclose levels up to 1% (much less act as a bilayer modifier).

## **2. No suggestion to modify reference**

Applicants respectfully point out that the initial burden is on the Examiner to provide a suggestion to modify the references to arrive at the claimed invention. Applicants respectfully assert the Office Action fails to do so, particularly in view of the claim amendments.

## **3. Reasonable Expectation of Success**

Applicants respectfully point out that the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. *See* M.P.E.P., section 2142. Applicants respectfully assert that the Office Action has not met this burden, particularly in view of the claim amendments.

In view of the foregoing, Applicants assert the Examiner has failed to meet all of the three requirements of a *prima facie* case of obviousness. Therefore, Applicants request withdrawal of the rejection and ask for allowance of the pending Claims.

## Conclusion


In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. sections 112, 103 and 102. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of the pending claims.

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Respectfully submitted,

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